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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/846,058      | 04/30/2001  | Jay K.. Bass         | 10004190-1          | 4485             |

7590 10/19/2004

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EXAMINER

EPPERSON, JON D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1639

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                        |                                      |                                    |  |
|------------------------|--------------------------------------|------------------------------------|--|
| <b>Advisory Action</b> | <b>Application No.</b><br>09/846,058 | <b>Applicant(s)</b><br>BASS ET AL. |  |
|                        | <b>Examiner</b><br>Jon D Epperson    | <b>Art Unit</b><br>1639            |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 29 and 31.

Claim(s) rejected: 1-9, 27, 28, 30 and 32-38.

Claim(s) withdrawn from consideration: 10-23.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Please see attached sheet

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The After-Final amendment is denied entry for the following reasons:

1. Applicants' amendments (e.g., see After Final Amendment, see entire document) do not place the case in immediate condition for allowance. For example, amended claim 1 is still anticipated by Indermuhle et al. because said reference does teach the disputed limitations (e.g., see After Final Amendment, especially pages 8-10). Here, Indermuhle et al. teach, "... different chemical moieties are placed along rows that are more closely aligned with a direction having a higher height uniformity" and "compar[ing] to identify a direction having a higher height uniformity." For example, Indermuhle et al. teach that the first and second directions have been compared and that the samples are placed in a direction along which the height uniformity is greater (e.g., on the tops of the pillars). In addition, the direction between Z and X-Y has also been compared (i.e., the samples are only placed on the "tops" of the pillars, not on the sides). Thus, the reference clearly anticipates Applicants' claimed invention no matter which direction you look at it. Applicants' inherency arguments are not convincing because Indermuhle et al. would not have made the pillars "flat" if they did not want "height uniformity" in those regions (i.e., they inherently compared the height and put the samples only in those regions because they knew the height in those regions was uniform). Any other interpretation of this reference would be unreasonable because the pillar chip would not work unless a "comparison" of the height uniformity was made (i.e., it has to be this way, it's not an "option" as suggested by Applicants). In addition, Applicants broadened the "objectionable" claims introducing new search and consideration and the possibility of new matter (e.g., see claim 29 wherein Applicants removed a

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significant portion of dependent claim 4 step (a) from the newly amended claim 29, thus broadening it).

2. There is no reason given for why the amendment was not earlier presented.

In order to expedite the future prosecution of the present application the following comments are noted:

3. Applicants' arguments with regard to Cattell under 35 U.S.C. 103(a) are found persuasive in light of Applicants' statement that both applications were commonly owned at the time the invention was made.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/846,058

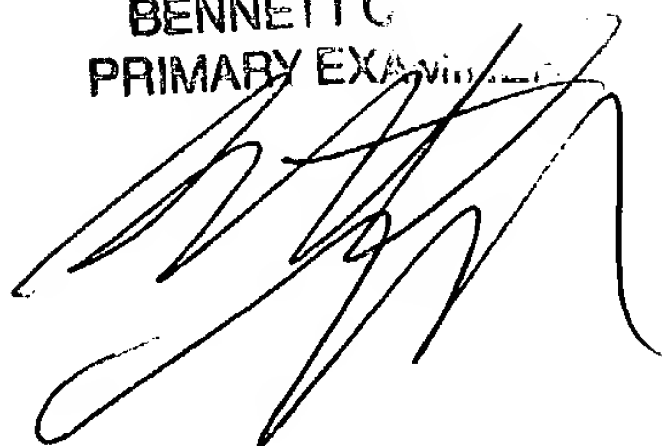
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Jon D. Epperson, Ph.D.

October 12, 2004

BENNETT C  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be "B. Epperson", is written over the printed name "BENNETT C. EPPERSON" and the title "PRIMARY EXAMINER".